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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,724	03/19/2001	Masahiro Inoue	01145/LH	9510
1933	7590	10/11/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			BOUTAH, ALINA A	
		ART UNIT		PAPER NUMBER
		2143		
DATE MAILED: 10/11/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/811,724	INOUE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alina N Boutah	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 05 July 2005.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) 7-10 and 21 is/are withdrawn from consideration.
- 5) Claim(s) 12-14, 19 and 20 is/are allowed.
- 6) Claim(s) 1-6, 11, 15 and 18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.



**DETAILED ACTION**

***Response to Amendment***

This action is in response to Applicant's amendment filed December 29, 2004.

Claims 16-25 have been newly added. Claim 2 has been cancelled. Claims 1, 3-5, 7, 9-13 and 14 have been amended. Claims 1 and 3-21 are pending in the present application.

***Election/Restrictions***

Applicant's election without traverse of claims 1, 3-6, 11-20 in the reply filed on July 5, 2005 is acknowledged.

***Specification***

Applicant has amended the title of the invention to be more clearly indicative of the present claimed invention.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 5 recite the limitation "the advertisement distribution system." There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,334,109 issued to Kanevsky et al. (hereinafter referred to as Kanevsky) in view of USPN 6,351,745 issued to Itakura et al. (hereinafter referred to as Itakura).

(Amended) Regarding claim 1, Kanevsky teaches an advertisement distribution system which receives advertisement contents from advertisement provider terminals through a communications network, and provides advertisement user terminals with the received advertisement contents through the communication network, said system comprising:

a receiver which receives from the advertisement provider terminals through the communication network advertisement contents and associated advertisement provider information which is specified by content providers, the advertisement provider information including advertisement providing conditions for controlling provision of the associated advertisement contents (abstract; figure 1; col. 1, lines 10-24; col. 1, line 59 to col. 2, line 7);

an advertisement information storage unit which stores advertisement contents and associated advertisement provider information received by the receiver (col. 1, lines 66 to col. 2, line 7);

an advertisement-user information storage unit which stores identification data designating the advertisement user terminal and associated advertisement usage information specified by advertisement users, the advertisement usage information including an advertisement specification condition for specifying a desired advertisement of the advertisement users (col. 2, lines 17-36);

an advertisement contents extracting unit which extracts the advertisement contents associated with the advertisement provider information extracted by the advertisement provider information extraction unit, from the advertisement information storage unit (col. 2, lines 44-57), and

a transmission unit which transmits the advertisement contents extracted by said advertisement contents extraction until to the advertisement user terminal designated by the associated identification data (abstract).

Regarding claim 3, Kanevsky fails to explicitly teach the advertisement distribution system according to claim 1, wherein said advertisement contents extraction unit includes an advertisement selection unit which selects, when more than a predetermined number of items of advertisement provider information including the searched advertisement providing condition are retrieved, a predetermined number of items of advertisement provider information included in the retrieved items of advertisement provider information. Itakura teaches a predetermined number of items of advertisement provider information included in the retrieved items of advertisement provider information (col. 5, lines 1-28). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teaching of Itakura

with the teaching of Kanevsky in order to keep track the number of times the advertisement has been transmitted to users, therefore always keeping users updated on products, therefore maximizing the system's efficiency.

Regarding claim 11, Kanevsky teaches a method of receiving advertisement contents sent from an advertisement provider using an advertisement provider terminal through a communications network, and sending the received advertisement contents to at least one advertisement user terminal from an advertisement server, said method comprising the steps of:

receiving, from the advertisement provider terminals through the communication network, advertisement contents and associated advertisement attribute information which is specified by the provider of the advertisement contents, the advertisement attribute information representing an advertisement providing condition for controlling provision of the associated advertisement contents (abstract; figure 1; col. 1, lines 0-24; col. 1, line 59 to col. 2, line 7);

storing the advertisement content and advertisement attribute information received in said receiving step (col. 2, lines 17-36);

storing advertisement user information sent from the at least one advertisement user using the advertisement contents (abstract, figure 1; col. 1, line 59 to col. 2, line 7, lines 17-37);

retrieving advertisement attribute information conforming to the stored advertisement user information, and extracting advertisement contents corresponding to

the retrieved advertisement attribute information; sending the extracted advertisement contents to the at least one advertisement user (figure 3, 209; col. 2, lines 44-57);

sending the extracted advertisement contents to the at least one advertisement user (abstract);

receiving predetermined advertisement contents sent from said advertisement server to the at least one advertisement user and advertisement attribute information corresponding to the predetermined advertisement contents, and storing the received advertisement contents and the advertisement attribute information sequentially in received order (col. 1, lines 66 to col. 2, line 7);

outputting and specifying one advertisement content included in the stored advertisement contents, when using an advertisement (abstract); and

outputting the advertisement content specified by said outputting step (abstract).

Regarding claim 15, Kanevsky teaches a computer readable recording medium which records a program for controlling a computer function as:

a receiver which receives from the advertisement provider terminals through the communication network advertisement contents and associated advertisement provider information which is specified by content providers, the advertisement provider information including advertisement providing conditions for controlling provision of the associated advertisement contents (abstract; figure 1; col. 1, lines 0-24; col. 1, line 59 to col. 2, line 7);

an advertisement information storage which stores advertisement contents and associated advertisement provider information received by the receiver (abstract, figure 1; col. 1, line 59 to col. 2, line 7, lines 17-37);

an advertisement usage information storage unit which stores identification data designating the advertisement user terminal and associated advertisement usage information specified by advertisement users, the advertisement usage information including an advertisement specification condition of the advertisement users (abstract, figure 1; col. 1, line 59 to col. 2, line 7, lines 17-37);

an advertisement provider information extraction unit which extracts, from the advertisement information storage unit the advertisement provider information which conforms to the advertisement specification condition included in the advertisement usage information associated with the identification data (col. 2, lines 44-57);

an advertisement content extracting unit which extracts the advertisement contents associated with the advertisement provider information extracted by the advertisement provider information extraction unit from the advertisement information storage unit (col. 2, lines 44-57); and

a sending unit which sends the advertisement contents extracted by said advertisement content extraction unit to the advertisement user terminal designated by the associated identification data (abstract).

Claims 18 is similar to claims 1, therefore is rejected under the same rationale.

***Response to Arguments***

Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive.

In response to Applicant's argument that Kanevsky fails to teach that the provider of advertisement designates the providing conditions of the advertisement and that designates advertisement usage conditions, the Patent Office respectfully submits that this is taught in abstract, figure 1 as well as col. 1, line 59 to col. 2, line 7, lines 17-37 of Kanevsky. Specifically, the cited area of Kanevsky teaches creating an advertisement that is personalized to a particular user. In this case, the "personalization" of an advertisement is interpreted as a "condition" as claimed.

***Allowable Subject Matter***

In the office action mailed September 13, 2004, the Examiner has indicated that claims 4-6 and 12-14 would be allowable if rewritten in independent form. In response, Applicant has amended claims 4, 5 and 12 in independent form. However, claims 4 and 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Claims 16-17 and 19-20 are similar to claims 4-5, therefore are allowed for the same rationale.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2143

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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